

### REMARKS

Applicants have canceled claims 1-44 and added claims 45-67. The new claims correspond essentially to the claims as originally filed in the parent application. For example, new claim 45 recites a cloning system comprising (a) an Ad backbone plasmid having an Ad genome that lacks map units 0 to 9.2, and (b) a shuttle plasmid having Ad sequences from 0 to 1 and 9.2 to 16.1. Claim 45 further recites that the numbering of the map units starts with the lefthand ITR. Similarly, new claims 59 and 64 recite, respectively, a host cell comprising the cloning system of claim 45, and a method for making recombinant adenovirus using the cloning system of claim 45.

Support for these new claims can be found throughout the specification and in the original claims. In particular, independent claims 45, 54, 59, and 64 correspond to original claims 16, 11, 17, and 22. In addition, support for the phrase "wherein the numbering of the map units starts with the lefthand ITR" can be found in the specification at, for example, page 6, lines 21-23. New dependent claims 46-53, 55-58, 60-63, and 65-67 correspond to original claims 2-8, 10, 12-15, 18-21, and 23-25. Support for the phrase "cDNA of interest" in claims 57 and 67 can be found in the specification at, for example, page 3, lines 10-12, page 6, lines 19-20, and page 15, lines 15-17. Furthermore, support for the phrase "assaying for" in claim 66 can be found in the specification at page 12, lines 13-14, page 14, lines 28-30, and page 15, line 26. No new matter has been added.

In light of these amendments and the following remarks, Applicants respectfully request examination and allowance of claims 45-67.

### Interview Summary

Applicants' agent thanks Examiner Foley for the courtesy of a personal interview on March 31, 2004. The interview included a discussion of the rejections within the outstanding Office Action, as well as a discussion of claim amendments proposed by the Applicant.

Double patenting

The Examiner objected to claim 44 under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 36. Applicants have canceled claims 36 and 44. Thus, this objection is moot.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 36 and 44 under 35 U.S.C. § 103(a) as being unpatentable over the Aoki *et al.* reference (*Molecular Medicine* 5:224-231, 1999) and the He *et al.* reference (U.S. Patent No. 5,922,576). Applicants have canceled claims 36 and 44, rendering this rejection moot.

Insofar as the previous rejections are applied to the pending claims, Applicants submit herewith the attached Declarations and Exhibits. The Examiner in an earlier Office Action indicated that the Aoki *et al.* reference was prior art under 35 U.S.C. § 102(a), which requires that the invention is “known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent . . .” The attached Declarations and Exhibits establish that Aoki *et al.* does not meet the requirements of 35 U.S.C. § 102(a).

Declaration by Kevin Clark Under 37 C.F.R. § 1.132, with copy of cover pages – This Declaration states that Applicants’ agents were able to obtain a copy of the April 1999 issue of *Molecular Medicine*, in which the Aoki *et al.* reference appeared. As stated in the Declaration, this copy was obtained from the Countway Library of Medicine at Harvard University, and was date stamped June 15, 1999.

Declaration by Elizabeth N. Kaytor Under 37 C.F.R. § 1.132, with copy of cover pages – This Declaration states that Applicants’ agents were able to obtain a copy of the April 1999 issue of *Molecular Medicine* from the Bio-Medical Library at the University of Minnesota. This copy also was date stamped June 15, 1999.

Declaration by Inventors Under 37 C.F.R. § 1.132, with Exhibits A-H –

This Declaration states that the inventors conceived of the present invention and worked diligently to reduce the invention to practice prior to the date on which the Aoki *et al.* reference became publicly available. The attached exhibits, which include copies of laboratory notebook pages, sequence data, a transfection worksheet, a plasmid stock spreadsheet, a seminar announcement, and a summary of the invention, provide support for the Declaration. Applicants' agent notes that at the time the Declaration was sent to the inventors for execution, Applicants were planning to file a continuation rather than an RCE; therefore the Declaration does not list the serial number of the application in the header.

In summary, the attached Declarations of Kevin Clark and Elizabeth N. Kaytor establish that while the Aoki *et al.* article appeared in the April 1999 issue of *Molecular Medicine*, the April 1999 issue did not become publicly available until June 15, 1999. The attached Declaration by Inventors establish that the claimed invention was invented by the Inventors prior to June 15, 1999. Thus, the Inventors invented the claimed invention prior to the publication of the April 1999 issue of *Molecular Medicine*. Therefore, the invention was not "known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," as required by 35 U.S.C. § 102(a). As such, Applicants respectfully submit that the presently claimed invention is patentable.

Applicant : Beverly L. Davidson et al.  
Serial No. : 09/521,524  
Filed : March 8, 2000  
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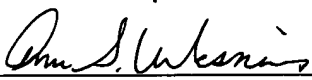
Attorney's Docket No.: 17023-005001 / 00015

### CONCLUSION

Applicants respectfully submit that claims 45-67 are in condition for allowance, which action is requested. The Examiner is invited to telephone the undersigned if such would further prosecution. Enclosed is a check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 20 April 2004

  
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